

Serial No. 10/696,295

PATENT
Docket No. 85804-010801REMARKS

The application has been reviewed in light of the Office Action dated June 16, 2005. Claims 1 to 31 are pending, of which Claims 1, 11, 16 and 24 are independent. Reconsideration and further examination are respectfully requested.

The Application as originally filed included Claims 1 to 30. During prosecution of the Application, original claims 29 and 30 were inadvertently excluded from the listing of claims, and a new Claim 29 was added in the Amendment filed on December 17, 2004. In order to remove any confusion which may have resulted, Claims 29 and 30 are being cancelled, and new Claims 31 to 33 are being added, herein. Claim 31 and 32 correspond to originally-filed Claims 29 and 30, and Claim 33 corresponds to Claim 29 added in the Amendment filed on December 17, 2004.

Applicants gratefully acknowledge the indication of withdrawal of the 35 U.S.C. § 101 rejection of Claims 1 to 6, 11 to 14, 16, 22, 23, 25 and 26.

By the Office Action, Claims 1 to 29 are rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,740,549 (Reilly). Reconsideration and withdrawal of the rejection are respectfully requested.

Claim 1 recites a method for providing an ad via a computer network. According to the method, an ad input file is combined with a conduit file to create an integrated ad file containing computer code for providing the ad. The ad input file identifies the content of the ad and the conduit file identifies tracking data for the ad. The integrated ad file is served from a computer to provide the ad.

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The Office Action contends that Reilly at col. 5, line 47 to col. 6, line 10 and col. 8, lines 50 to 53 discloses "combining an advertisement file with a conduit (tracking) file to create an integrated advertisement file containing the advertisement content and the tracking data."

Reilly, at col. 5, line 47 to col. 6, line 10 describes "from time to time" upgrading procedures, i.e., administration management and information viewing procedures, on a user computer, such that when it is determined these procedures should be upgraded, they are downloaded at the same time that information items and advertisements are downloaded to the user computer. Reilly only periodically downloads the procedures, and when the procedures are to be downloaded, Reilly simply describes that the procedures are downloaded to the user computer as discrete items during the same transmission session as other discrete items, such as information items and advertisements. The procedures described in Reilly are clearly not contained in an integrated ad file. Nothing in the cited portion of Reilly describes serving an integrated ad file, which combines an ad input file that identifies the content of an ad and a conduit file that identifies tracking data for the ad, the integrated ad file containing computer code for providing the ad.

The cited portion of Reilly also refers to an information database 134. Referring to Figure 1, information database 134 has entries for news story items 132, advertisements 138, images 140, display scripts 142, software for downloading to clients 144, client catalog 146, advertising display statistics 148, and news item display statistics 149. However, the information database 134 in Reilly is simply a database for storing discrete items. Further, information database 134 does not refer to or contain an integrated ad file. Nothing in the information database 134 combines an ad input file and a conduit file. In addition, as described in Reilly, the

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advertising display statistics 148 are collected from the user computer when the user computer calls in for updated news stories. Advertising display statistics uploaded from the user computer are not the same as a conduit file which identifies tracking data for an ad, the conduit file contained in an integrated ad file, which further contains an ad input file that identifies the content of an ad and computer code for providing the ad.

At col. 8, lines 50 to 53, Reilly states that images, including advertisements, and software modules are compressed using well known data compression technologies to make the download transmission as time efficient as possible. The cited portion of Reilly simply describes that an image can be compressed to reduce the size of the image, or that a software module can be compressed to reduce the size of the software module. However, use of a compression scheme to reduce the size of a discrete item is clearly not the same as creating an integrated ad file by combining an ad input file that identifies content of the ad with a conduit file that identifies tracking data for the ad to create an integrated ad file. Nothing in the cited portion of Reilly describes such an integrated ad file which further contains computer code for providing the ad.

Should the Examiner persist in his rejection of Claim 1 on these grounds, the Examiner is respectfully requested to specifically point out by drawing, reference number and paragraph citation the specific elements of Reilly that the Examiner equates to a conduit file identifying tracking data for the ad file, an integrated ad file which includes computer code for providing an ad and which is created by combining an ad input file with a conduit file. See MPEP § 706.02(j). Such new grounds for rejection should be made non-final.

The Office Action cites Reilly, col. 5, line 47 to col. 6, line 10 and col. 8, lines 50 to 53, and then states:

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"[w]hile Reilly does not explicitly disclose that the advertisement file and the tracking file are combined during the transmission to the client computer, the cited passage discloses that the transmission will include a plurality of objects, such as information items, advertisements, display statistics, update data, update data [sic], etc. It is well known to combine such objects into a batch file for transmission over the network. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the conduit file with the advertisement file to which it pertained. One would have been motivated to combine these files in this manner in order to enable the client computer to more easily identify the correlation between the files and in order to facilitate the batch transmissions discussed by Reilly."

The Office Action fails to provide any support for the stated motivation to make the combination suggested in the Office Action. As the courts have clearly indicated, the Examiner must set forth with specificity where the motivation exists in the cited references, or, if the Examiner is relying on general knowledge of the art, that general knowledge must be capable of readily documented substantiation. See In re Lee, 277 F.3d 1338, 1343 and In re Zurko, 258 F.3d 1379, 1383-86. If the Examiner is relying on well-known facts or common knowledge in the art to provide the motivation, such facts and knowledge must be of a nature that are "capable of instant and unquestionable demonstration as being well-known." MPEP § 2144.03.A., citing In re Ahlert, 424 F.2d 1088, 1091 (CCPA 1970) (requiring that the notice of facts beyond the record which may be taken by the Examiner must be capable of instant and unquestionable demonstration so as to defy dispute).

The Examiner is required to place himself in the shoes of a person of ordinary skill in the art at the time the invention was made. See In re McLaughlin, 443 F.2d 1392 (CCPA 1971). It is this hindsight to which the McLaughlin case refers, which hindsight, in the context of McLaughlin, limits the Examiner only to that which was known to the person of ordinary skill at the pertinent time to which the rejection applies. As the Courts have amply set forth subsequent

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to McLaughlin, the Applicants' invention may not be used as the hindsight roadmap with which the Examiner winds his way through the prior art for identifying features and then, using the teachings of the claimed invention, "use that which the inventor has taught against its teacher" to provide the missing motivation to combine the references to yield the claimed invention. In re Lee, 277 F.3d 1338, 1344, citing W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1993). As the Federal Circuit stated in In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999);

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See e.g., C.R. Bard, Inc. v. M3 Sys., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998) (describing "teaching or suggestion or motivation [to combine]" as an "essential evidentiary component of an obviousness holding"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("the Board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them"); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]"); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1998) (evidence of teaching or suggestion "essential" to avoid hindsight)...Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight. See e.g., Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985) ("The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time.")

There is no showing of any support in the Office Action for the stated motivation to combine the common knowledge assertions (which assertions are themselves improper as discussed above) with the teachings of Reilly. Without such a showing in the prior art, it can only be said that the disclosure of the present application is being used as a blueprint to modify the teachings of Reilly to reject the claims of the present invention.

In view of the above, it is submitted that the Office Action uses Applicant's own disclosure to provide the otherwise missing motivation to modify Reilly to yield the claimed invention, which is not permitted, as clearly stated by the courts in the case law discussed above.

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The Office Action fails to make the evidential showing required to establish a prima facie case of obviousness under 35 U.S.C. § 103(a).

The Office Action alleges that Reilly discusses batch transmissions. However, a search of Reilly conducted by Applicants' undersigned attorney failed to locate a single reference to "batch", or "batch transmission". Should the Examiner persist in his rejection on these grounds, the Examiner is respectfully requested to specifically point out by drawing, reference number and paragraph citation the specific elements of Reilly that the Examiner equates to a batch and a batch transmission. In addition, See MPEP § 706.02(j). Such new grounds for rejection should be made non-final.

Based on the factual and legal deficiencies noted above, reconsideration and withdrawal of the 35 U.S.C. § 103(a) are respectfully requested. The applied art, namely Reilly, either alone or in combination (n.b., such combination is not believed to be permissible, as discussed above) is not seen to teach, suggest or disclose each and every one of the features recited in Claim 1. Reconsideration and withdrawal of the rejection of Claim 1 are therefore respectfully requested.

Claim 11 recites a method of facilitating providing an ad by loading an ad file. According to the method, first and second files are identified. A placeholder is identified in the first file, and the second file is electronically inserted into the placeholder to create the ad file. The ad file includes computer code for providing the ad.

Based on the above discussion, Reilly fails to disclose an ad file which includes computer code for providing an ad. In addition, Reilly fails to disclose identifying a placeholder in a first file, and electronically inserting a second file into the placeholder to create an ad file.

More particularly and as discussed above, col. 5, line 47 to col. 6, line 10 and col. 8, lines 50 to 53, Reilly fails to disclose or suggest an ad file which includes computer code for providing

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an ad. In addition, nothing in the cited portions of Reilly disclose or suggest identifying a placeholder in a first file, and electronically inserting a second file into the placeholder to create an ad file.

The Office Action refers to an "insertion point". However, a search of Reilly failed to locate a reference to an "insertion point". Should the Examiner persist in his rejection on these grounds, the Examiner is respectfully requested to specifically point out by drawing, reference number and paragraph citation the specific elements of Reilly that the Examiner equates to an insertion point, and a placeholder. See MPEP § 706.02(j). Such new grounds for rejection should be made non-final.

The applied art, namely Reilly, either alone or in combination (n.b., such combination is not believed to be permissible, at least for the reasons discussed above) is not seen to teach, suggest or disclose each and every one of the features recited in Claim 11. In addition and for at least the same reasons, Reilly is not seen to teach, suggest or disclose each and every one of the features of Claims 16 and 24. Reconsideration and withdrawal of the rejection of Claims 11, 16 and 24 are therefore respectfully requested.

The other claims are each dependent from the independent claims discussed above and are therefore believed patentable for at least the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however, the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

The Applicant respectfully requests that a timely Notice of Allowance therefore be issued in this case. Should matters remain which the Examiner believes could be resolved in a further

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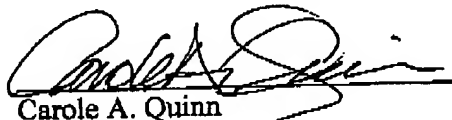
telephone interview, the Examiner is requested to telephone the Applicant's undersigned attorney.

In this regard, Applicant's undersigned attorney may be reached by phone in California (Pacific Standard Time) at (714) 708-6500. All correspondence should continue to be directed to the below-listed address.

The Commissioner is hereby authorized to charge any required fee in connection with the submission of this paper, any additional fees which may be required, now or in the future, or credit any overpayment to Account No. 50-2638. Please ensure that the Attorney Docket Number is referred when charging any payments or credits for this case.

Respectfully submitted,

Date: October 17, 2005



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LA-FS1361437v03